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EXAMINER
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GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
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3692

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09/29/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,975	<b>Applicant(s)</b> PARSONS ET AL.	
	<b>Examiner</b> Clement B. Graham	<b>Art Unit</b> 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/24/03</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

1. Claims 1-23 remained pending.

#### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1, 18, and 23, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims recite 1, 18, 23, a process for verifying fund's performance comprising; receiving "comparing" "presenting" storing". Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claims 1, 18, and 23, are directed towards a process for verifying fund's performance comprising; comprising steps and modules. Modules and steps can be interpreted at consisting of software per se, and software is not a patentable subject matter because it do not fall under a statutory class as being a process, machine, manufacture, or composition of matter.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kam et al (Hereinafter Kam US PUB: 2001/0042037A1) in view of Hillel US PUB: 2003/0028459A1)

As per claim 1, Kam discloses a method for verifying a fund's performance comprising:

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receiving from data a net asset value for a fund owned by a customer; comparing the net asset value to one or more historical net asset values for the customer to obtain a variance that characterizes a difference (see column 10 para 0089 and column 12 para 0119) between the net asset value and the one or more historical net asset values (see column 4 para 0029-0029 and column 5 para 0035 and column 1 para 0005) when the variance is within a tolerance for the net asset value, storing the net asset value in a database (see column 5 para 0035) and when the variance is not within the tolerance for the net asset value values (see column 11 para 0116 and see column 10 para 0089)

(i) presenting a plurality of preset explanations for the variance to the data (see column 10 para 0089 column 7 para 0069 and 0055) (ii) requiring the data to select one of the plurality of preset explanations for the variance (see column 9 para 0082) and (iii) storing the net asset value and the one of the plurality of preset explanations in the database values (see 0055 and column 4 para 0029).

Kam fail to explicitly teach data provider.

However Hillel discloses can process real-time data provided by a third party data provider FIG. 1A shows the third party data provider as a stand-alone computer; however, it is to be understood that third party data provider can be a central computer such as a mainframe, minicomputer, or other such combinations comprising storage media and computer systems known to those skilled in the art, using as examples only, providers such as Dow-Jones Inc., or LEXIS-NEXIS. The present invention can also process financial data that has been stored, whether on a computer of the user, or stored by another computer system and which is in communication with the computer system of the user. In one embodiment of the present invention, data provided by the third party data provider is transmitted to computer by a communications means such as a high speed data network (see column 3 para 0037).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was to modify the teachings of Kam to include data provider in order taught by Hillel in order to is particularly suited for analyze the performance of securities, such as stocks, mutual funds or the like over a period of time.

As per claim 2, Kam discloses wherein theis at least one of a third-party data or a fund manger values (see column 1 para 0012-0014 and column 2-6 para 0015-0052).

Kam fail to explicitly teach data provider.

However Hillel discloses can process real-time data provided by a third party data provider FIG. 1A shows the third party data provider as a stand-alone computer; however, it is to be understood that third party data provider can be a central computer such as a mainframe, minicomputer, or other such combinations comprising storage media and computer systems known to those skilled in the art, using as examples only, providers such as Dow-Jones Inc., or LEXIS-NEXIS. The present invention can also process financial data that has been stored, whether on a computer of the user, or stored by another computer system and which is in communication with the computer system of the user. In one embodiment of the present invention, data provided by the third party data provider is transmitted to computer by a communications means such as a high speed data network (see column 3 para 0037).

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was to modify the teachings of Kam to include data provider in order taught by Hillel in order to is particularly suited for analyze the performance of securities, such as stocks, mutual funds or the like over a period of time.

As per claim 3, Kam discloses wherein the tolerance is user-modifiable values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 4, Kam discloses wherein the tolerance is a range of acceptable percentage variations values (see column 1 para oo12-0014 and column 2-6 para 0015-0052).

As per claim 5, Kam discloses wherein the acceptable percentage variations are based on a month-end to month-end variation in at least one of the Dow Jones Industrial Average or the Standard and Poors 500 values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 6, Kam discloses wherein the range of acceptable percentage variations is a range of between +/- 5% and +/- 30% values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 7, Kam discloses wherein the range of acceptable percentage variations is determined relative to the one or more historical net asset values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 8, Kam discloses wherein the range of acceptable percentage variations is determined relative to the received net asset value(see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 9, Kam discloses wherein the tolerance is a range of acceptable absolute variations (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 10, Kam discloses wherein the range of acceptable absolute variations is a range of between +/- \$100 million and +/- \$2 billion (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 11, Kam discloses wherein the tolerance is an asymmetrical range of acceptable variations (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 12, Kam discloses wherein a tolerance is determined individually for each one of a plurality of different funds owned by the customer(see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 13, Kam discloses wherein the tolerance is adjusted according to a market condition (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

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As per claim 14, Kam discloses wherein the plurality of preset explanations for the variance includes at least one of asset transfers, benefit payments, incorrect prior month values, cash influxes, cash withdrawals(see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119) collateral NAV changes, contributions, conversions closing of funds, merger of funds, supplied and client verified NAVs, derivative fluctuations, changes in security market values, expenses, fund mergers, holding accounts, liquidation of partial assets, new money from shareholders, creation of a new fund, shareholder distributions, shareholder redemptions, shareholder subscriptions, trading activities, favorable or unfavorable exchange rates, or valid zero asset balances (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 15, Kam discloses wherein the preset explanations are edited by an authorized user (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 16, Kam discloses wherein receiving a net asset value for a fund further comprises receiving at least one of a spreadsheet, a comma delimited file, or a tab delimited file that contains the net asset value (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 17, Kam discloses wherein receiving a net asset value for a fund further comprises receiving a net asset value that is manually entered through a user interface (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005 and see column10 para 0089 and column 12 para 0119).

As per claim 18, Kam discloses a computer program product for verifying a fund's performance comprising:

A computer readable medium having stored thereon;

computer executable code for receiving from a net asset value for a fund owned by a customer computer executable code for comparing the net asset value to one or more historical net asset values for the customer to obtain a variance that characterizes a difference (see column10 para 0089 and column 12 para 0119) between the net asset value and the one or more historical net asset values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005) computer executable code for storing the net asset value in a database when the variance is within a tolerance for the net asset value (see column 5 para 0035) and computer executable code for, when the variance is not within the tolerance for the net asset value (see column 11 para 0116)

:i) presenting a plurality of preset explanations for the variance to the data provider (see column 10 para 0089 column 7 para 0069 and 0055) (ii) requiring the to select one of the plurality of preset explanations for the variance(see column 9 para 0082) and (iii) storing the net asset value and the one of the plurality of preset explanations in the database(see 0055 and column 4 para 0029).

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Kam fail to explicitly teach data provider.

However Hillel discloses can process real-time data provided by a third party data provider FIG. 1A shows the third party data provider as a stand-alone computer; however, it is to be understood that third party data provider can be a central computer such as a mainframe, minicomputer, or other such combinations comprising storage media and computer systems known to those skilled in the art, using as examples only, providers such as Dow-Jones Inc., or LEXIS-NEXIS. The present invention can also process financial data that has been stored, whether on a computer of the user, or stored by another computer system and which is in communication with the computer system of the user. In one embodiment of the present invention, data provided by the third party data provider is transmitted to computer by a communications means such as a high speed data network (see column 3 para 0037).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was to modify the teachings of Kam to include data provider in order taught by Hillel in order to is particularly suited for analyze the performance of securities, such as stocks, mutual funds or the like over a period of time.

As per claim 19, Kam discloses a system for verifying a fund's performance comprising:  
means for receiving from a data a net asset value for a fund owned by a customer means for comparing the net asset value to one or more historical net asset values for the customer to obtain a variance that characterizes a difference (see column10 para 0089 and column 12 para 0119) between the net asset value and the one or more historical net asset values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005)  
means for storing the first net asset value in a database when the variance is within a tolerance for the net asset value (see column 5 para 0035) and means for, when the variance is not within the tolerance for the first net asset value (see column 11 para 0116)  
(i) presenting a plurality of preset explanations for the variance to the data (see column 10 para 0089 column 7 para 0069 and 0055) (ii) requiring the data to select one of the plurality of preset explanations for the variance(see column 9 para 0082) and  
(iii) storing the net asset value and the one of the plurality of preset explanations in the database (see 0055 and column 4 para 0029).

As per claim 20, Kam discloses a system for verifying a fund's performance comprising:  
a database having storage for financial data for one or more funds the financial data for the one or more funds including one or more historical net asset values for the one or more funds (see column 5 para 0035) a client device connected in a communicating relationship with a network, the client device receiving fund data relating to the one or more funds, the fund data including a new net asset value for at least one of the one or more funds values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005) a server connected in a communicating relationship with the database and the client device, the server receiving the fund data from the client device and executing a process to compare the new net asset

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value to the one or more historical net asset values(see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005)

the process further configured to present a plurality of preset explanations to the client device when a variance between the new net asset value and the one or more historical net asset values exceeds a tolerance (see column 10 para 0089 column 7 para 0069 and 0055) and, when the tolerance is exceeded, further configured to store the new net asset value only when a selected one of the plurality of preset explanations has been received from the client device values (see column 11 para 0116 and see column 10 para 0089)

Kam fail to explicitly teach data provider.

However Hillel discloses can process real-time data provided by a third party data provider 40. FIG. 1A shows the third party data provider as a stand-alone computer; however, it is to be understood that third party data provider can be a central computer such as a mainframe, minicomputer, or other such combinations comprising storage media and computer systems known to those skilled in the art, using as examples only, providers such as Dow-Jones Inc., or LEXIS-NEXIS. The present invention can also process financial data that has been stored, whether on a computer of the user, or stored by another computer system and which is in communication with the computer system of the user. In one embodiment of the present invention, data provided by the third party data provider is transmitted to computer by a communications means such as a high speed data network (see column 3 para 0037).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was to modify the teachings of Kam to include data provider in order taught by Hillel in order to is particularly suited for analyze the performance of securities, such as stocks, mutual funds or the like over a period of time.

As per claim 21, Kam discloses the server further configured to present a user interface to a second client device, the user interface providing controls for adding, deleting, or modifying one of the plurality of preset explanations(see column 1 para 0012-0014 and column 2-6 para 0015-0052).

As per claim 22, Kam discloses the server further configured to present a user interface to a second client device, the user interface providing controls for modifying the tolerance (see column 1 para 0012-0014 and column 2-6 para 0015-0052).

As per claim 23, Kam discloses a method for verifying data values comprising:  
receiving a value for a measurement from a data;  
comparing the value to one or more historical values for the measurement to obtain a variance that characterizes a difference (see column 10 para 0089 and column 12 para 0119) between the value and the one or more historical values (see column 4 para 0029 -0029 and column 5 para 0035 and column 1 para 0005)

when the variance is within a tolerance for the value, storing the value in a database (see column 5 para 0035) and when the variance is not within the tolerance for the value values (see column 11 para 0116 and see column 10 para 0089) ( i ) presenting a plurality of preset explanations for the variance to the data (see



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column 10 para 0089 column 7 para 0069 and 0055) (ii) requiring the to select one of the plurality of preset explanations for the variance(see column 11 para 0116 and see column 10 para 0089 column 7 para 0069 and 0055) and (iii) storing the net asset value and the one of the plurality of preset explanations in the database (see 0055 and column 4 para 0029).

Kam fail to explicitly teach data provider.

However Hillel discloses can process real-time data provided by a third party data provider 40. FIG. 1A shows the third party data provider as a stand-alone computer; however, it is to be understood that third party data provider can be a central computer such as a mainframe, minicomputer, or other such combinations comprising storage media and computer systems known to those skilled in the art, using as examples only, providers such as Dow-Jones Inc., or LEXIS-NEXIS. The present invention can also process financial data that has been stored, whether on a computer of the user, or stored by another computer system and which is in communication with the computer system of the user. In one embodiment of the present invention, data provided by the third party data provider is transmitted to computer by a communications means such as a high speed data network (see column 3 para 0037).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was to modify the teachings of Kam to include data provider in order taught by Hillel in order to is particularly suited for analyze the performance of securities, such as stocks, mutual funds or the like over a period of time.

## **Conclusion**

### ***Response to Arguments***

6. Applicant's argument filed 2/11/08 has been fully considered but they are moot in view of new grounds rejections.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CG  
September 18, 2008

/Kambiz Abdi/  
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3692